

Appl. No. 10/823,917  
Amdt. dated August 14, 2006  
Reply to Office action of May 12, 2006

Remarks/Arguments

Claims 1-7, 16-18, 24 and 26-31 are pending. Claims 1-7, 24 and 26-28 are allowed.

Claims 16-17 and 29-30 stand rejected as anticipated by Wright under 35 U.S.C. 102(e).

Claims 18 and 31 stand rejected as unpatentable over Wright under 35 U.S.C. 103(a).

Reconsideration and withdrawal of these rejections is respectfully requested in view of the foregoing amendments and for the following reasons.

As discussed in the previous amendment, the Wright patent describes a golf club head designed, like numerous other prior art golf club heads, so that the head will initially impact a golf ball with a resilient insert mounted within a recess adjacent the lower edge of the club head.

Applicant's golf club head is the opposite of prior art golf club heads in that it is designed so that a golf ball is initially impacted by the non-resilient surface of the head above the resilient area, with the ball only subsequently contacting the resilient area of the head.

Applicant's claims define this distinction by the inclusion of the clause: "...whereby said ball will be initially struck by said non-resilient initial impact area and then by said resilient section." However, the examiner holds that this "whereby" phrase does not distinguish the invention, and instead merely addresses the manner in which the ball is struck.

While a whereby clause is not given weight when it simply expresses the intended result, the Federal Circuit has held that a "whereby" clause cannot be ignored where the clause states a condition that is material to patentability. See *Hoffer v. Microsoft Corp.* 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005). MPEP 2111.04. Here, the whereby clause does define

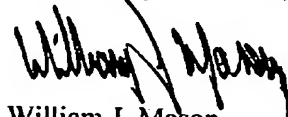
a condition that is material to patentability, namely the location of the initial impact area above the resilient area. Note that the club being claimed is a putter. A golfer would have to misuse the Wright putter more like a sand wedge to meet applicant's requirements.

Furthermore, the distinguishing limitation is not only recited in the whereby clause, but is also specifically stated in the body of the claim. Specifically, the rejected independent claims state that the putter includes "a non-resilient ball initial impact area above said recess".

Newly added claim 32 provides the further distinction of requiring that "said initial impact area is about 0.6 inch above said front surface lower edge."

For the forgoing reasons, and in view of the amendments to the claims, it is believed that this application now defines a patentably distinguishable invention and is accordingly in condition for allowance. Such action is respectfully solicited.

Respectfully submitted,



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